UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,110	11/02/2000	Charlotte G. Peterson	60709-00016	4996

7590 09/15/2005	EXAMINER

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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/705,110</td><td>Applicant(s)
PETERSON ET AL.</td></tr>
<tr><td>Examiner
Igor Borissov</td><td>Art Unit
3639</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 June 2005</u>.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5, 7-23, 25-34, 36-84 and 86-118* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-5, 7-23, 25-34, 36-84 and 86-118* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/2005 has been entered.

Response to Amendment

Amendment received on 6/30/2005 is acknowledged and entered. Claims 6, 24, 35 and 85 have been canceled. Claims 1, 10, 26-31, 34, 36, 37, 47-50, 95 and 114-118 have been amended. Claims 1-5, 7-23, 25-34, 36-84 and 86-118 are currently pending in the application.

Claim Objections

Claim Objections have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 101

Claim Rejections under 35 USC § 101 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50-118 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 50 and 114-118 includes the term "means for", which is not provided in the specification. Furthermore, Claim 114 includes the term "module", which is not provided in the specification. The remaining Claims are rejected as being dependent on the rejected independent Claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-17, 19, 24-34, 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (US 5,845,065) in view of Jacobson (US 6,735,701) and further in view of Hedstrom et al. (US 6,477,471).

Independent Claims

Claims 1, 50, 114 and 117-118. Conte teaches a method and system for network license compliance, comprising:

identifying at least one required software (C. 7, L. 3-15); conducting acquisition process and deploying said identified software (C. 6, L. 39-43); storing information relating to software owned or licensed by a business entity, including maintaining and reviewing software license assignments (C. 6, L. 63-65); unassigning (retiring) software (C. 15, L. 31-33); tracking software licenses (C. 15, L. 47-50).

Conte does not specifically teach *installing updated software; transmitting data from the server to the at least one client system to display an assessment worksheet, said worksheet including at least one question relating to the acquired software asset; prompting a user to respond to the at least one question displayed; processing at least*

one response received from the user; and calculating a sigma value based at least in part on the at least one response received from the user; wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Jacobson teaches a method and system for network policy management, software compliance and effectiveness system, including: purchasing and upgrading software (C. 20, L. 50-51); and further including presenting via a Training Module a network user with a template (worksheet) (C. 5, L. 51-52), said presenting step further including displaying to said user policy recommendation questions (*prompting a user to respond to the at least one question displayed*) (C. 6, L. 13-14); and processing responses received from said user by the policy effectiveness system to determine policy training needs and policy compliance history (compliance with the software management process) (C. 5, L. 60-63; C. 20, L. 14-15).

Hedstrom et al. (Hedstrom) teaches a method and system for analyzing quality of the software development process, wherein the historical data, indicating defect containment in software development, is processed and sigma values are computed (C. 2, L. 34-38).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Conte to include upgrading said software, and obtaining from the users information relating to the corresponding software, as disclosed in Jacobson, because it would advantageously allow to provide said business entity with the latest version of the required software, and provide personnel training to enable compliance with the software management.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Conte and Jacobson to include that said processing at least one response received from the user includes calculating a sigma value based at least in part on the at least one response received from the user as disclosed in Hedstrom, because use of statistical tools for analyzing policy compliance would

advantageously allow to compute predicted deviations of policy compliance, thereby increase accuracy of the system.

Claims 47, 115 and 116. Conte teaches said method and system, comprising: accessing information from a license pool (centralized database) including the name of the suite, the license number, the names of the applications and an identification of the users who are using the various applications (C. 7, L. 10-32); searching said pool in response to inquiry received from a user (C. 6, L. 39-43); retrieving and presenting said information to the user for tracking and monitoring (C. 15, L. 47-50); reviewing (auditing) software license assignments (C. 6, L. 63-65).

Conte does not specifically teach *transmitting data from the database to the computer to display an assessment worksheet, said worksheet including at least one question relating to the acquired software asset; prompting a user to respond to the at least one question displayed; processing at least one response received from the user; and calculating a sigma value based at least in part on the at least one response received from the user; wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.*

Jacobson teaches said method and system for network policy management, software compliance and effectiveness system, including purchasing and upgrading software (C. 20, L. 50-51); and further including presenting via a Training Module a network user with a template (worksheet) (C. 5, L. 51-52), said presenting step further including displaying to said user policy recommendation questions (*prompting a user to respond to the at least one question displayed*) (C. 6, L. 13-14); and processing responses received from said user by the policy effectiveness system to determine policy training needs and policy compliance history (compliance with the software management process) (C. 5, L. 60-63; C. 20, L. 14-15).

Hedstrom teaches said method and system for analyzing quality of the software development process, wherein the historical data, indicating defect containment in software development, is processed and sigma values are computed (C. 2, L. 34-38).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Conte to include upgrading said software, and obtaining from the users information relating to the corresponding software, as disclosed in Jacobson, because it would advantageously allow to provide said business entity with the latest version of the required software, and provide personnel training to enable compliance with the software management.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Conte and Jacobson to include that said processing at least one response received from the user includes calculating a sigma value based at least in part on the at least one response received from the user, as disclosed in Hedstrom, because use of statistical tools for analyzing policy compliance would advantageously allow to compute predicted deviations of policy compliance, thereby increase accuracy of the system.

Dependent Claims

Claim 2, storing information relating to software owned or licensed by a business entity, including maintaining and reviewing software license assignments (C. 6, L. 63-65), and update the database to indicate which applications are being run by which users (Conte; C. 10, L. 53-55).

Claim 3, storing user's identification (Conte; C. 7, L. 15; C. 8, L. 47-48).

Claims 4-5, storing application's pertinent details (Conte; C. 6, L. 15-16; C. 7, L. 10-15).

Claim 7. Jacobson teaches: providing a licensed software for a business entity, wherein a user's name, title, email address, department and employment status is stored (C. 20, L. 2-8). The motivation to combine Conte and Jacobson would be to simplify assessment of the status of the licensed software.

Claim 8, conducting a transaction with a vendor (Conte; C. 25, L. 10), thereby inherently indicating *storing vendor-related information*.

Claims 9-10, Jacobson teaches: providing training materials on-line (Figs. 24-26; C. 19, L. 18-19; C. 20, L. 14). The motivation to combine Conte and Jacobson would be to simplify assessment of the status of the licensed software.

Claims 11-12, matching user's *needs* with existing licenses (Conte; C. 7, L. 11-12), thereby inherently indicating *defining and analyzing business requirements*.

Claim 13, Jacobson teaches: analyzing local regulations (C. 19, L. 26-28). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claim 14, matching user's *needs* with existing licenses, said matching is conducted in a plurality of steps (Conte; C. 7, L. 11-12), thereby inherently indicating *reviewing and finalizing* method steps.

Claim 15, identifying software alternatives (Conte; C. 7, L. 7-35).

Claim 16, matching user's *needs* with existing licenses, said matching is conducted in a plurality of steps (Conte; C. 7, L. 11-12), thereby inherently indicating *evaluating and checking* method steps.

Claims 17 and 19, making a decision to use an existing software (Conte; C. 7, L. 7-35).

Claim 25, tracking licenses, and updating the database with the current information relating to licenses (Conte; C. 15, L. 46-60).

Claims 26-27 and 30-31, Jacobson teaches: providing information about justification for software purchases, upgrades and maintenance expense (C. 20, L. 50-51). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claim 28, Jacobson teaches: purchasing and upgrading software (C. 20, L. 50-51). The motivation to combine Conte and Jacobson would be to provide said business entity with the latest version of the required software, thereby enhancing the performance of the system.

Claim 29, Jacobson teaches: updating software purchase related information (C. 20, L. 33-36). The motivation to combine Conte and Jacobson would be to provide said

business entity with the latest version of the required software, thereby enhancing the performance of the system.

Claims 32, Jacobson teaches: revising licensing information (C. 19, L. 9-11). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claim 33, Jacobson teaches: updating the system with the purchasing information (C. 19, L. 4-16). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claim 34, Jacobson teaches: monitoring effectiveness of the current policy, and users compliance with the current policy obviously indicates evaluating exposure of a department (C. 19, L. 4-16). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claim 36. Hedstrom teaches a method and system for analyzing quality of the software development process, wherein the historical data, indicating defect containment in software development, is processed and sigma values are computed (C. 2, L. 34-38). The motivation to combine Conte and Jacobson with Hedstrom would be to enable the computation of predicted deviations of policy compliance by means of statistical tools, thereby increase accuracy of the system.

Claim 37, Jacobson teaches: downloading a new policy if it was determined that the current policy is not effective obviously indicates implementing corrective actions (C. 19, L. 9-11). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claims 38, entering information via a keyboard (Conte; C. 25, L. 36; C. 10, L. 53-55).

Claims 39-40. Jacobson teaches: providing information in response to an inquiry, including downloading said information (downloading a new policy when a policy is ineffective) (C. 19, L. 10-12). The motivation to combine Conte and Jacobson would be to enable close monitoring of compliance with the software management.

Claim 41, Jacobson teaches: printing requested information (C. 15, L. 29-33). The motivation to combine Conte and Jacobson would be to provide a hard copy of the

requested information to prevent loss of the requested information in case of power failure.

Claims 42-43. Jacobson teaches: displaying information on the client system; and prompting the client to download a new policy (C. 19, L. 10-12), thereby indicating accepting an inquiry from the client system to download said new policy.

Claim 44. Conte teaches the use of Microsoft Office ®, thereby indicating the use pull down menus (C. 2, L. 15-16).

Claim 45. Jacobson teaches: downloading said new policy over the Internet thereby indicating the use of HTML for linking user to an appropriate Web site (C. 19, L. 10-12; C. 5, L. 40).

Claim 46. Conte teaches that the client system and the server are connected via Ethernet networks (C. 1, L. 31).

Claims 51-66, 68-77 and 88-113. See reasoning applied to the corresponding method Claims.

Claims 18, 20-23, 67, 78-84 and 86-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte in view of Jacobson further in view of Hedstrom and further in view of Aycock et al. (US 5,765,138).

Claim 18. Conte, Jacobson and Hedstrom teach all the limitations of claim 18, except specifically teaching *submitting a request for proposal and a request for information to prospective vendors; and reviewing results*.

Aycock teaches a method and system for providing an interactive evaluation of potential vendors, wherein a request for proposal or request for quotation (information) to prospective vendors is submitted, and vendors responses are scored and evaluated (C. 1, L. 48-51).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Conte, Jacobson and Hedstrom to include submitting a request for proposal to prospective vendors and reviewing results, as disclosed in

Aycock, because submitting a request for proposal to multiple vendors would advantageously allow to determine the best suitable vendor for the job.

Claim 20, Conte teaches: making a decision to use an existing software, and implementing said decision, obviously indicates approving said decision (C. 7, L. 20-35).

Claim 21, Conte teaches: said computer-implemented method steps, wherein all steps related to making said decision to use an existing software, and implementing said decision, are recorded in the database (C. 7, L. 20, 26, 34, 57-63).

Claim 22, Jacobson teaches said method, wherein monitoring of said software compliance and effectiveness further includes monitoring value of software being used at any time, and software and licensing cost/usage (equity investment) (C. 20, L. 55-58); type of software agreements, coordination of software license agreement with software utilization (contract terms and conditions) (C. 20, L. 47-48); potential policy infringements, and allocation of usage-related costs (legal and financial requirements) (C. 20, L. 62-M). The motivation to combine Conte with Jacobson would be to enable close monitoring of compliance with the software management.

Claim 23, Aycock teaches: selecting a vendor for a software project (C. 2, L. 61-63; C. 3, L. 22-23). The motivation to combine Conte and Jacobson with Aycock would be to determine the best suitable vendor for the job.

Claims 67, 78-84 and 86-87. See reasoning applied to Claims 18, 20-23.

Response to Arguments

Applicant's arguments filed 6/30/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that Conte does not teach auditing the acquired software asset by transmitting data from a server to a client system to display an assessment worksheet on the client system, wherein the worksheet includes at least one question relating to the acquired software asset, it is noted that Jacobson was applied for this feature. Specifically, Jacobson teaches said method and system for network policy management, software compliance and effectiveness system, including

purchasing and upgrading software (C. 20, L. 50-51); and further including presenting
via a Training Module a network user with a template (worksheet) (C. 5, L. 51-52), said
presenting step further including displaying to said user policy recommendation
questions (*prompting a user to respond to the at least one question displayed*) (C. 6, L.
13-14); and processing responses received from said user by the policy effectiveness
system to determine policy training needs and policy compliance history (compliance
with the software management process) (C. 5, L. 60-63; C. 20, L. 14-15).

In response to the applicant's argument that Conte does not teach installing
updated software, it is noted that Jacobson was applied for this feature (C. 20, L. 50-
51).

In response to the applicant's argument that Conte does not teach the use of a
web-based system for managing software assets, the examiner points out that Conte
teaches the use of various types of network (C. 1, L. 30-34). As per the Internet,
Jacobson explicitly disclose the use of the Internet (C. 5, L. 40).

In response to the applicant's argument that Conte does not teach reviewing
software license, and retiring a software asset, it is noted that Conte teaches
maintaining and reviewing software license assignments (C. 6, L. 63-65); and
unassigning (retiring) software (C. 15, L. 31-33).

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Igor Borissov whose telephone number is 571-272-
6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for
the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
Art Unit 3639

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9/09/2005